

## REMARKS

### Summary of the Office Action

Claims 1-14 and 18-22 are pending. Claims 1-14 and 18-22 have been rejected under 35 U.S.C. 103(a) as allegedly obvious over U.S. Patent No. 6,547,801 to Dargent et al. ("Dargent") in view of U.S. Patent No. 6,889,086 to Mass et al. ("Mass") and of U.S. Patent No. 6,527,701 to Sayet et al. ("Sayet").

### Response to the Office Action

#### **A. Amendments to the Specification**

Paragraphs [0066], [0068] and [0078] have been amended to correct typing errors. No new matter has been added.

#### **B. The Rejection under 35 U.S.C. 103(a)**

Claims 1-14 and 18-22 are pending in the application. Claims 1, 4-9, and 18-22 are currently amended. Therefore, upon entry of the present amendment, claims 1-14 and 18-22 will be subject to examination.

A prima facie case of obviousness requires: (1) a suggestion or reason to combine; (2) a reasonable expectation of success; and (3) a teaching or suggestion of all claim limitations in the prior art. *Brown & Williamson Tobacco Corp. v. Philip Morris*, 229 F.3d 1333, 1342 (Fed. Cir. 2003); *In re Regal*, 526 F.2d 1399, 1403 (C.C.P.A. 1975).

Independent claims 1, 12, and 18, as currently amended, are not obvious in view of the cited references because Dargent, Mass and Sayet, alone or in combination, fail to teach or suggest "an internal oscillator" which is "influenced by a signal directly derived from or supplied to the stepper motor."

Dargent teaches an implantable constriction device having a tractile element that is actuated by an intracorporeal induction coil, magnetically connected to an extracorporeal resonance coil driven by an extracorporeal oscillator. *Dargent*, Specification; Col. 4, lines 1-14, 18-22; FIG. 5. Additionally, Dargent does not teach using the signal derived from or supplied to the stepper motor to influence the intracorporeal oscillator, so that the feedback

of information can be done directly, without requiring processing by a microprocessor in the implant. Further, the Examiner has acknowledged that Dargent does not teach the use of a stepper motor nor the use of passive telemetry in intracorporeal devices.

The deficiencies of Dargent are not resolved by combining the disclosure of Dargent with those of Maas and Sayet. Mass teaches a passive telemetry system that includes a microprocessor that operates as a controller of the device and that supervises collection of data. Mass, Col. 2, line 67 – Col. 3, line 4; Col. 3, lines 51-55; FIG. 1. Sayet instead teaches an implantable apparatus for controlling fluid flow within a host body, which includes a constricting member that has a plunger member for reducing fluid flow and that includes a stepper motor in certain embodiments. *Sayet*, Abstract; Col. 3, line 63 – Col. 4, line 13; Col. 5, lines 4-11.

Neither Maas nor Sayet teach positioning the oscillator intracorporeally, nor providing feedback by passive telemetry through an intracorporeal oscillator that is influenced by a signal directly derived from, or supplied to, a stepper motor, so that actuation is correlated to the number of pulses provided to the motor coils.

Because Dargent, Maas, and Sayet, alone or in combination, provide no teaching or suggestion that would have motivated one skilled in the art to develop an implantable device that includes the features of Applicants' invention, withdrawal of the rejection of independent claims 1, 12, and 18 under 35 U.S.C. 103(a) is respectfully requested. The remaining claims depend, directly or indirectly, from independent claims 1, 12, and 18 and are allowable over the prior art of record at least for the same reasons as the independent claims. In particular, claims 4-9 and 19-21 have been amended to maintain consistency with the limitations of claims 1 and respectively 18.

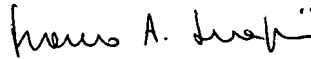
The Examiner has observed that "the claims do not contain any limitations that the device does not contain a microprocessor." Applicants note that negative limitations are disfavored in claim drafting practice and believe that the term "directly" properly indicates the nature of the connection between the oscillator and the stepper motor described in the specification.

**Conclusion**

In view of the foregoing amendment and comments, Applicants respectfully submit that the present application is now in condition for allowance. An early and favorable reply is earnestly requested. If necessary, the Commissioner is hereby authorized in this and concurrent replies to charge payment (or credit any overpayment) to Deposit Account No. 50-2298 of Luce, Forward, Hamilton & Scripps.

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Respectfully submitted,



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